

REMARKS

Claims 1-21 were pending in this application.

Claims 1-21 have been rejected.

Claims 1, 4, 5, 8, 10 and 21 have been amended as shown above.

Claim 3 has been canceled.

Claims 1, 2 and 4-21 are now pending in this application.

Reconsideration and full allowance of Claims 1, 2 and 4-21 are respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 112

The Office Action rejects Claim 21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner noted that it is unclear which device "said device" is referring to. In response, the Applicant has amended Claim 21 to recite "each said slave device" to make clear which device Applicant is referring to.

II. REJECTIONS UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-2, 10 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,962,992 to Huang et al. ("*Huang*"). In view of the above amendments, this rejection is respectfully traversed. Support for the above amendments can be found throughout the specification. As an example, support may be found on page 5, lines 11-19 and page 6, line 18 through page 7, line 15 of the specification of the present application.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Huang recites a lighting control system that controls the operation of lamps and other electrical appliances. (*Abstract*). The system includes a master controller (element 100), zone controllers (elements 110), and slave units (elements 120). (*Abstract*). The master controller controls the zone controllers, the zone controllers control the slave units, and the slave units control the electrical appliances. (*Col. 6, Lines 19-23*). To install a slave unit, a user depresses a button or buttons on the slave unit, causing an install LED, if present on the slave unit, to turn on, indicating that the installation process has been initiated. (*Col. 27, Lines 44-54; Col. 29, Lines 34-47*). Thereafter, the user depresses a button or buttons on the controller (master/zone/IR) to install the slave unit on the controller. (*Col. 27, Line 55 – Col. 28, Line 10; Col. 29, Lines 47-55*).

Thus, in *Huang*, the visual confirmation on the slave unit (install LED turning on) occurs prior to the selection of the slave unit on the master/zone/IR controller. By contrast, Claims 1, 10 and 21 of the present invention each similarly recite: “a visual confirmation performed by each of the plural lighting devices upon selection of each of the plural lighting devices on the remote control.” *Huang* lacks any mention that the visual confirmation could be performed upon

selection by the controller. In fact, *Huang* teaches away from the presently claimed invention by requiring the user to first depress buttons on the slave unit, causing the visual confirmation, before the user can depress buttons on the controller to complete installation. For at least these reasons, *Huang* fails to anticipate the Applicant's invention as recited in Claims 1, 10 and 21 (and their dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejections and full allowance of Claims 1, 2, 10 and 21.

III. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejects Claims 5-7 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* in view of U.S. Patent No. 5,936,362 to Alt et al. ("*Alt*"). The Office Action rejects Claims 3-4 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* in view of *Alt* and further in view of U.S. Patent No. 6,163,275 to Hartzell et al. ("*Hartzell*"). The Office Action rejects Claims 8, 9, 17 and 19-20 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* in view of U.S. Patent No. 5,847,955 to Mitchell et al. ("*Mitchell*").

The Office Action further rejects Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* in view of *Mitchell* and further in view of U.S. Patent No. 6,333,605 to Grouev et al. ("*Grouev*"). The Office Action rejects Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* in view of Applicant's admitted prior art ("*AAPA*"). The Office Action rejects Claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* in view of *AAPA* and further in view of U.S. Patent No. 5,986,574 to Colton et al. ("*Colton*"). The Office Action

rejects Claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* in view of *AAPA* and *Colton* and further in view of U.S. Patent No. 6,675,196 to Kronz ("*Kronz*"). The Office Action rejects Claims 15, 16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* in view of U.S. Patent No. 5,962,992 to Meier et al. ("*Meier*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Claims 3-4 and 12-14 depend from Claim 1. Claims 11, 19 and 20 depend from Claim 10. As described above, Claims 1 and 10 each similarly recite: “a visual confirmation performed by each of the plural lighting devices upon selection of each of the plural lighting devices on the remote control.” The Applicant respectfully submits that such a feature is not disclosed, taught or suggested in any of the cited references, alone or in combination.

Independent Claims 5 and 8 each now recite “a visual confirmation” performed by each of the slave devices “upon selection” of the slave devices on the master device. The Applicant respectfully submits that such a feature is not disclosed, taught or suggested in any of the cited references, alone or in combination. Claims 6-7 and 15-16 depend from Claim 5. Claims 9 and 17-18 depend from Claim 8.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejections and full allowance of Claims 4-9 and 11-20.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY


For the reasons given above, the Applicant respectfully requests reconsideration and allowance of all pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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